



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,674	09/18/2003	Robert H. Kummer JR.	F-723	4064

7590
Brian A. Lemm
Pitney Bowes Inc.
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484

12/08/2008

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
----------	--------------

3628

MAIL DATE	DELIVERY MODE
-----------	---------------

12/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT H. KUMMER, JR. and
JACQUES E. HASBANI

Appeal 2008-4088
Application 10/664,674
Technology Center 3600

Decided: December 5, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-15 which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellants' claimed invention is directed to a system and method for processing mail pieces to automatically associate a manually entered postage to a class of service. A postage amount is entered by a user to be applied to mail pieces. Stored information including rate tables are searched for one or more classes of service having a postage rate that matches the entered postage amount. (Specification, [0005]). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method for processing one or more mail pieces, comprising:
 - receiving a postage amount entered by a user, said postage amount to be applied to said one or more mail pieces;
 - searching stored information including one or more rate tables for one or more classes of service having a postage rate that matches said postage amount;
 - if no class of service having a postage rate that matches said postage amount is found, displaying an error message;
 - if one or more classes of service having a postage rate that matches said postage amount is found, displaying said found one or more classes of service to said user;
 - receiving a selected class of service, said selected class of service being selected by said user from said displayed one or more classes of service;
 - applying said postage amount to said one or more mail pieces;
 - and
 - storing transaction information for each of said one or more mail pieces, said transaction information including said postage amount and said selected class of service.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Barns-Slavin	US 5,072,397	Dec. 10, 1991
Raju	US 2003/0037008 A1	Feb. 20, 2003
Chernin	US 6,643,694 B1	Nov. 4, 2003

The following rejections are before us for review:

1. Claims 1-15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Barns-Slavin, Raju, and Chernin.

THE ISSUE

The issue is whether the Appellants have shown that the Examiner erred in rejecting the claims 1-15 under 35 U.S.C. § 103(a) as unpatentable over Barns-Slavin, Raju, and Chernin.

This issue turns on whether any of the references disclose that if one or more searched classes of service has a postage rate that matches the user entered postage amount is found then displaying the found one or more classes of service to the user.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence¹:

FF1. Barns-Slavin discloses a system in which depression of a key indicates a carrier (such as USPS) for shipping and the class of service. Based on the weight of the parcel the calculations for shipping are made. (Col. 3:20-42).

FF2. Raju discloses in Fig. 11 that a user enters a postage amount 1120-11 and selects a class of service from a drop down menu 1180.

FF3. Raju does not disclose that if one or more searched classes of service have a postage rate that matches the user entered postage amount is found then displaying the one or more classes of service to said user.

FF4. Chernin does not disclose that if one or more searched classes of service have a postage rate that matches the user entered postage amount is found then displaying the one or more classes of service to said user.

FF5. Chernin discloses a system that generates an error message.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

Appeal 2008-4088
Application 10/664,674

subject matter pertains.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious.

ANALYSIS

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Barns-Slavin, Raju, and Chernin is improper because none of the references teach or suggest the invention (Br. 7-8). The Appellants argue that Barns-Slavin is a conventional system in which a user weighs a piece of mail, selects a class of service, and then in which the system determines the proper postage (Br. 5). The Appellants argues that in Raju, the user inputs a desired postage rate and then the user selects a postage rate class (Br. 6). The Appellants argue that Raju does not disclose the limitation that “if one or more classes of service ha[s] a postage rate that matches said postage amount is found, displaying said found one or more classes of service to said user” as recited in claim 1 because:

The system of Raju does not search for a class of service having a postage rate that matches the input postage amount, it simply *displays all classes* and allows the user to make a selection, *regardless of whether or not the selected class supports the input postage rate*. (Brief 6, emphasis added).

The Examiner argues Raju discloses a user inputting a postage amount and the user searching through one or more rate classes in a drop down menu and selecting a rate class that matches the entered postage amount. The Examiner argues that claim 1 does not specify who or what performs the searching step (Ans. 12-13). The Examiner has determined that Raju discloses that if one or more classes having a postage rate matches the user entered postage amount is found, then displaying the found classes to the display (Ans. 8).

We agree with the Appellants. Claim 1 includes the limitation that “if one or more classes of service ha[s] a postage rate that matches said postage amount is found, displaying one or more classes of service to said user”. The Examiner has determined that this feature is disclosed by Raju in Figs. 11, 13, and paragraphs 0078, 0080, and 0083 (Ans. 14). We disagree with this finding by the Examiner. Raju does not disclose that “if one or more classes of service ha[s] a postage rate that matches said postage amount is found, displaying one or more classes of service to said user” (FF3). In Raju, the user enters a postage amount, and then clicks on the drop down menu and selects a postage rate (FF2). In Raju it is not specifically disclosed that the drop down menu displays only classes of service that have a postage rate that match the user entered postage amount. Raju also does not disclose “displaying said found one or more classes of service to said user” since a drop down menu must be accessed manually by the user. The

Appeal 2008-4088
Application 10/664,674

Examiner has acknowledged that Barns-Slavin does not disclose “if one or more classes of service ha[s] a postage rate that matches said postage amount is found, displaying one or more classes of service to said user” (Ans. 4) and we have found that Chernin also fails to disclose this limitation as well (FF4).

For the above reasons, the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Barns-Slavin, Raju, and Chernin is not sustained. The Appellants have provided the same arguments for claim 8 which contains limitations similar to claim 1. Accordingly the rejection of claim 8 under 35 U.S.C. § 103(a) as unpatentable over Barns-Slavin, Raju, and Chernin is not sustained for the same reasons above. The rejection of claims 2-7 and 9-15 under 35 U.S.C. § 103(a) as unpatentable over Barns-Slavin, Raju, and Chernin which each depend from claim 1 or claim 8 is not sustained for these same reasons above.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-15 under 35 U.S.C. § 103(a) as unpatentable over Barns-Slavin, Raju, and Chernin.

DECISION

The Examiner’s rejection of claims 1-15 is not sustained.

REVERSED

Appeal 2008-4088
Application 10/664,674

LV:

Brian A. Lemm
Pitney Bowes Inc.
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484